

**In the Figures:**

Please replace Figure 1 with the attached replacement sheet.

## **REMARKS**

The Applicant has filed the present Response in reply to the outstanding Official Action of September 23, 2005, and the Applicant believes the Response to be fully responsive to the Official Action for the reasons set forth below in greater detail.

Applicant would like to note that Figure 1 has been amended herewith. Specifically, reference numbers 65, 66, and 67 have been removed from the figure. The reference numbers were not used in the specification and are not needed to fully describe the claimed invention. Applicant would also like to note that Claims 12 and 13 have been added to the application for examination. Claim 12 is an independent claim that corresponds to the subject matter of original Claim 6, rewritten in independent format. Accordingly, Applicant submits that Claim 12 should be allowed. Claim 13 is an independent claim that is directed to the subject matter of Claims 1 and 6. Applicant submits that Claim 13 is patentable for at least the reasons set forth herein.

Claims 1, 10 and 11 have been amended herewith to clarify the invention. No new matter has been added by the aforementioned amendments.

## **CLAIM OBJECTIONS**

In the outstanding Official Action, the Examiner objected to Claims 1, 10 and 11 because of several minor informalities. Claims 10 and 11 have been amended to overcome the objection. With respect to Claim 1, the claim has been amended to correct a minor editorial error. However, Applicant disagrees with the Examiner's opinion that the claim language should be changed to "sections to make one of said resonant circuits." Claim 1, line 11 recites, "one of said resonant circuit" and the limitation in-issue, at line 14 of the claim, refers to the limitation in line 11; therefore, the claim should read, "said one of said resonant circuit". The claim has been amended to reflect this correction.

Accordingly, Applicant believes that the amendments to Claims 1, 10 and 11 obviate the Examiner's objections to the claims.

### **§ 112, SECOND PARAGRAPH REJECTION**

Further, Claims 3 and 8 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which the Applicant regards as the invention. Specifically, the Examiner avers that the claims fail to specify what the source and the drain are connected to. Applicant disagrees with the rejection. The specification describes that the first and second transistors are connected to a first and second output terminal (drains) and the source is connected to the drain of the bias transistor. See Abstract. See also page 10. Claims 3 and 8 state that one of the source and drain is connect to the output terminal and the other is connected to a second potential. The input signal is inputted to the gate. See Figure 3. Therefore, Applicant submits that Claims 3 and 8 specify "what the source and drain are connected to". Furthermore, one of ordinary skill in the art would understand what was meant by the language in the claim. Accordingly, Applicant submits that the claims, "particularly point out and distinctly claim the subject matter, which the Applicant regards as the invention" as required by the statute.

### **§ 103 REJECTION**

The Examiner also rejected Claims 1-5 and 7-11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Appln. No. 2003/0184378 to Segawa et al. (hereinafter "Segawa") in view of U.S. Patent No. 6,060,956 issued to Mole et al. (hereinafter "Mole").

Applicant respectfully disagrees with the rejection and traverses with at least the following analysis. Applicant submits that the rejection is fatally flawed. The references are

improperly combined. The Examiner has not provided a proper motivation to combine the references. Therefore, rejection is an improper hindsight rejection.

Specifically, Applicant submits that the Examiner has not established a *prima facie* case for obviousness. To establish obviousness, the Examiner must make a showing of a suggestion or motivation in the art to combine the references. In re Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. See Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997). “The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.” Teleflex, Inc. v. Ficosa North American Corp., 299 F.3d 1313, 63 U.S.P.Q.2d 1374 (Fed. Cir. 2002) (Citing In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999)).

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). “The Office may not... resort to speculation, unfounded assumptions, or **hindsight reconstruction to support deficiencies in its factual basis.**” In re GPAC, Inc., 57 F.3d 1573, 35 U.S.P.Q.2d 1116, 1123 (Fed. Cir. 1995).

The instant rejection relies upon Applicant’s own disclosure for motivation to combine the references. The Official Action reads that “One would be motivated to do this to control the peaking position and correspond to frequencies other than frequencies presumed in the design”. This is a direct quote from the instant application. See page 3. However, this is the very problem that the Applicant is solving, a problem only recognized by the Applicant. The Examiner does not point to any suggestion or teaching from any of the cited references that provide a motivation

or suggestion to make such a combination or modification. Additionally, the Examiner failed to provide any evidence that others recognized this problem. Accordingly, the rejection is fatally flawed. Since the Examiner provides no motivation for combining the cited teachings, the Examiner's rejection constitutes impermissible hindsight reconstruction based on Applicant's own disclosure.

Moreover, Segawa is directed to a differential amplifier that includes a variable inductor in order to allow the cut-off frequency to be controlled by an external signal. In contrast, Mole discloses a VCO that includes a variable capacitor in order to allow the oscillation frequency of the output to be variable depending on the input voltage. Both the circuit structures and functional advantages of the devices described by the two cited references are different. Furthermore, both functional improvements of the two different circuits are different. Clearly, there is no motivation to combine these two distinct circuit structures and functions.


Accordingly, Applicant submits that Claims 1-5, and 7-11 are patentably distinct from the hypothetically combined references. Claim 13 is patentable based upon the same reasoning.

For all the foregoing reasons, the Applicant respectfully requests the Examiner to withdraw the rejection of Claims 1-5, and 7-11 pursuant to 35 U.S.C. § 103(a). Applicant respectfully requests the Examiner to also withdraw the rejection of Claims 3 and 8 pursuant to 35 U.S.C. § 112, second paragraph. Lastly, Applicant respectfully requests the Examiner to also withdraw the objections to Claims 1, 10 and 11.

In conclusion, the Applicant believes that the above-identified application is in condition for allowance and henceforth respectfully solicits the Examiner to allow the application. If the Examiner believes a telephone conference might expedite the allowance of this application, the

Applicant respectfully requests that the Examiner call the undersigned, Applicant's attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,

  
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Enclosure: Replacement Sheet Figure 1